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| 10/799,866 | 03/12/2004 | Hisashi Fukuda | FUJO 14.947A | 2656 |
| 26304 7590 12/08/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585 | | | | |
| EXAMINER | | | | |
| HOQUE, NAFIZ E | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/799,866

Applicant(s)

FUKUDA ET AL.

Examiner

NAFIZ E. HOQUE

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-106 is/are pending in the application.
4a) Of the above claim(s) 44-100 and 102-106 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 36-43 and 101 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/12/2004 and 11/02/2006
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I in the reply filed on 8/15/2008 is acknowledged.

Claim Objections

2. Claims 38 and 41-43 are objected to because of the following informalities:
 - Claim 38 recites "releasing a call from **the** exchange unit".
 - Claim 41 recites "**said** source terminal unit and **said** destination terminal unit".
 - Claim 42 recites "**said** source terminal unit and **said** destination terminal unit are connected to **the** exchange unit".
 - Claim 43 recites "**The** exchange unit".

The above terms lack antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 101 recites "a computer-readable storage medium" in which the specification describe as "through a network line 5903" (spec, page 141, line 19-20). Therefore it can be interpreted as a "signal". A "signal" embodying functional descriptive material is neither a process ("actions"), machine, manufacture nor composition of matter (i.e., tangible "thing") and therefore does not fall within one of the four categories

of § 101. Rather "signal" is a form of energy, in the absence of any physical structure or tangible material. Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory, under the present USPTO Interim Guidelines, 1300 Official Gazette Patent and Trademark Office 142 (Nov. 22, 2005).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 36, 41-43 and 101 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowater et al. (US 5,970,126).

Regarding claims 36 and 101, Bowater discloses a computer telephony integration client unit (fig. 1, element 71) for transmitting computer telephony integration control request information for use in requesting computer telephony integration control to a computer telephony integration server unit (fig. 1, element 50), comprising:

computer telephony integration control request information editing means for editing tile computer telephony integration control request information (fig. 5, 10); and

communications control means for communicating with the computer telephony integration server unit through a computer network the computer telephony integration control request information and information relating to the computer telephony integration control request information (fig. 1 – shows communicating with a server in a computer communication network).

Regarding claim 41, Bowater discloses wherein said source terminal unit and said destination terminal unit communicate with each other through the exchange unit and a switching network to which the exchange unit is connected (fig. 1, elements 30 and 20).

Regarding claim 42, Bowater discloses wherein said source terminal unit and said destination terminal unit are connected to the exchange unit and communicate with each other through an extension network controlled by the exchange unit (fig. 1, elements 81 and 82).

Regarding claim 43, Bowater discloses the exchange unit used in the computer telephony integration control system according to claim 36 (fig. 1, element 30).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bowater et al. (US 5,970,126) in view of Iida et al. (US 5,577,111).

Regarding claim 37, Bowater discloses wherein said computer telephony integration control request information contains information specifying issue/non-issue of a result notification (see fig. 7, element 820).

Bowater does not disclose wherein said computer telephony integration control request information contains information when information specifying issue of the result notification is set in the computer telephony integration control request information, said computer telephony integration server unit returns a notification as to whether or not the computer telephony integration control has been successfully performed within the monitor time set in the computer telephony integration control request information.

Iida discloses wherein said computer telephony integration control request information contains information when information specifying issue of the result notification is set in the computer telephony integration control request information, said computer telephony integration server unit returns a notification as to whether or not the computer telephony integration control has been successfully performed within the

monitor time set in the computer telephony integration control request information (col. 9, lines 20-34; fig. 7).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Bowater in view of Iida to set a time for the request and cancel the camp-on request if it is not answered within a certain period to avoid having a request that is infinitely long (Iida, col. 9, lines 20-34).

8. Claim 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowater et al. (US 5,970,126) in view of Farris (US 5,692,033).

Regarding claim 38, Bowater discloses a source terminal unit capable of calling a call from the exchange unit to a destination terminal unit.

Bowater does not disclose wherein said computer telephony integration control refers to two-point connection control to connect a source terminal unit capable of releasing a call from the exchange unit to a destination terminal unit.

Farris discloses wherein said computer telephony integration control refers to two-point connection control to connect a source terminal unit capable of releasing a call from the exchange unit to a destination terminal unit (col. 3, lines 29-52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Bowater in view of Farris to automatically connect the call when the line is available (Farris, col. 3, lines 31-37).

Regarding claim 39, Farris discloses wherein said two-point connection control is periodically performed until the destination terminal unit answers (col. 3, lines 45-52).

Regarding claim 40, Farris discloses wherein said two-point connection control is performed upon receipt of a call release notification indicating that the destination terminal unit is ready (col. 2, lines 13-16).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAFIZ E. HOQUE whose telephone number is (571)270-1811. The examiner can normally be reached on M-F Alternate Fridays Off 7:30 - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/NAFIZ E HOQUE/
Examiner, Art Unit 2614

/Ahmad F Matar/
Supervisory Patent Examiner, Art Unit 2614